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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,220	02/06/2001	Steve Alexander Whitlock	16600.105006	5736
20786	7590	05/18/2006	EXAMINER	
KING & SPALDING LLP			WEBB, JAMISUE A	
1180 PEACHTREE STREET			ART UNIT	
ATLANTA, GA 30309			PAPER NUMBER	

3629

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/778,220	WHITLOCK ET AL.	
	Examiner	Art Unit	
	Jamisue A. Webb	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant's invention claims a method for supporting the efficient transfer of baggage and calculating potential assignments and routes for the baggage. The claims even claim an equation used for calculating the cost of the assignment to determine the assignment solution. The specification fails to include a working example of how to calculate the cost for the assignments and determine the most efficient assignments and routes according to the variables claimed. The equation given, uses multiple variable for cost, such as "bag cost" and "stop cost" as well as "balance cost" and "pair cost", which the specification lacks a description of how these cost are obtained, it merely says they are set. Who are they set by? Are they a published standard cost? Applicant (page 8), further goes on to state the desired efficiency can be achieved by manipulating the values of the weighting factors (the costs above), but never discloses how they are manipulated to determine the efficiency. The specification states that the best solution will vary based on the most important and given the greatest weighting factor. One of ordinary skill in the art, would have to

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do undue experimentation to determine the cost of all the weighting factors, and how they are determined. Therefore one of ordinary skill in the art would not be able to read the specification and determine how to calculate the potential assignments and routes and determine the best assignment and route, without undue experimentation.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. With respect to Claim 1: the phrase “select a most efficient assignment from the plurality of costs of potential assignments” is indefinite. It is unclear to the examiner how an assignment can be selected from a plurality of costs. Is the applicant trying to state to “select a most efficient assignment using the plurality of costs of the potential assignments”?

6. With respect to Claims 5 and 9: the phrase “creating the plurality of costs of potential assignments “ is indefinite. Are the costs created, or are they calculated? If they are calculated, they are already calculated in Claim 1.

7. With respect to Claim 20: the phrase “formulating a plurality of costs” is indefinite. It is unclear to the examiner if the costs of the assignments are actually being calculated, or is it just being formulated. The word formulate is defined as reducing something down to a formula, it does not actually calculate anything. Therefore it is unclear if the costs are actually being

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calculated, or are they just being formulated. If the cost are not actually being calculated, then how can the most efficient assignment be determined.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glass et al. (6,278,965).

12. With respect to Claim 26: Glass discloses the use of a system with a central computer system (106), a server computer (104) running a software module (see Figure 1), one client

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computer (102) coupled to a server, and a second client coupled to a server (110). The examiner notes that Claims 26-28 are drawn to a network, or system claim, which gives weight to structure only. The descriptive limitations in the claims (such as for managing traveler processes and for transmitting passenger data, for calculating baggage assignments, a tug client and a dispatch client) are more recitations of intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is indeed to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

13. Glass discloses that the system have a central database, and fails to disclose the system having multiple databases. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the central database of Glass to have it be multiple databases, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177,179. Furthermore it would have been an obvious matter of design choice to a person of ordinary skill in the art to have multiple databases, instead of one database, because Applicant has not disclosed that having the database in the form of multiple databases, provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally as well with the databases being in the form of a central database, due to the fact that the information is still saved for ease of retrieval. Therefore, it would have been an obvious matter of design choice to modify Glass, to obtain the invention as specified in Claim 26.

14. With respect to Claim 27: Glass discloses the server having access to multiple systems (115 and 117) where information can be transmitted and retrieved.

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15. With respect to Claim 28: See Column 5, line s 45-47

16. With respect to Claims 1-25: Due to the 112 1st paragraph rejection, and the lack of support the specification has for the claims. The examiner cannot reasonably ascertain the scope of these claims. Therefore, a lack of prior art rejection, does not indicate that these claims are allowable.

Response to Amendment

17. The declaration under 37 CFR 1.132 filed 2/22/06 is insufficient to overcome the rejection of claims 1-25 based upon 112 1st paragraph as set forth in the last Office action because: The affidavit was made by one of the co-inventor's of the application. First, the co-inventor of the application is not considered to have an un-biased opinion, and could benefit from the decision. Second the co-inventor is considered to be one of expert skill in the art , due to the closeness of the inventor has with the subject matter. Therefore, how can a person of expert skill in the art, give an opinion on what one of ordinary skill in the art would know, due to the fact that the expert would have inside knowledge of the workings of the invention. As stated above, there are multiple variables, which the applicant has admitted effect the outcome of the most efficient assignment, such as bag cost, stop cost and balance cost, and yet the specification is silent as to how these are determined. Are they set? Are they given variables? Are they industry standards, or industry published? Each variable in the specification needs to be defined and given a full explanation of how it is obtained. Not enough information is given to determine what they variables are and how are they calculated, or set. Figure 6 appears to be something

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created by the applicant's own program, but again, it has not disclosed how the variables are obtained and where the numbers are coming from. The part of the specification where the examiner states there is a working example is merely a part of the calculation, the variables are still not being defined to allow one of ordinary skill in the art to determine these variables and determine the most efficient solution without ordinary skill in the art.

Response to Arguments

18. Applicant's arguments filed 2/22/06 have been fully considered but they are not persuasive.

19. With respect to Applicant's argument that the specification is fully enabled: the applicant has relied on the affidavit in part, as disclosed above, the affidavit is not persuasive. See above for response to affidavit.

20. Applicant's arguments with respect to claims 26-28 have been considered but are moot in view of the new ground(s) of rejection.

21. With respect to Applicant's argument that the limitations in Claims 26-28 do not disclose the same system features: The Glass reference discloses calculating routes, using a computer, therefore there is a software module. Whether the system of Glass is used to communicate to tug clients, or airplanes, they still have the same system structural limitations, as claimed and fully capable of performing the method limitations claimed. Therefore rejection stands as stated above.

22. With respect to Claims rejections of 1-25: See above.

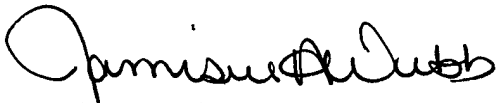
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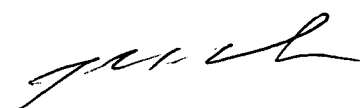
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamisue Webb


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